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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,368	02/14/2001	Robert Michael Getler	2000-0168.00	2311

21972 7590 02/15/2006

LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON, KY 40550-0999

EXAMINER

HILLERY, NATHAN

ART UNIT PAPER NUMBER

2176

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/783,368

Applicant(s)

GETLER ET AL.

Examiner

Nathan Hillery

Art Unit

2176

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

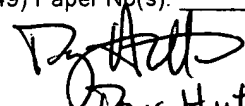
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
13. ☐ Other: _____.


Doug Hutton
Primary Examiner
Tech Center 2100

Continuation of 11. does NOT place the application in condition for allowance because:

1. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., 3-tier system (p 7, fourth paragraph) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Nevertheless, it should further be noted that Webopedia defines a server as a computer or device on a network that manages network resources. For example, a file server is a computer and storage device dedicated to storing files. Any user on the network can store files on the server. A print server is a computer that manages one or more printers, and a network server is a computer that manages network traffic. A database server is a computer system that processes database queries. Servers are often dedicated, meaning that they perform no other tasks besides their server tasks. On multiprocessing operating systems, however, a single computer can execute several programs at once. A server in this case could refer to the program that is managing resources rather than the entire computer (<http://www.pcwebopaedia.com/TERM/S/server.html>). Further, the Office maintains the rejection of the claims under 35 USC 103(a) as explained above and asserts that the combination of Rourke et al. and Reisman sufficiently teach, disclose and suggests the limitations as claimed.
2. In response to Applicant's arguments regarding the Office's use of dictionary definitions (p 8, fifth paragraph), it should be noted that the critical date of extrinsic evidence showing a universal fact need not antedate the filing date. See MPEP § 2124 (MPEP § 2131.01).
3. In response to applicant's argument that Reisman is nonanalogous art (p 9, second paragraph), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Reisman teaches a method for distributing information to a plurality of user stations each configured for communications with a multiplicity of servers via a non-proprietary network (Column 5, lines 19 – 22), which is in the field of applicant's endeavor.
4. In response to applicant's argument that neither Rourke et al. or Reisman teach, disclose, or suggest the limitation of claim 12 (p 10, second paragraph), it should be noted that at the very least Rourke et al. teach that system provides print processing for various workstations or clients. Clients, which may be remote and/or on site, are operatively coupled to printers through server (Column 6, line 60 – 64) and that Reisman teaches that Sending of information from the user to web package server 136 can be accommodated, if desired, using the bidirectional capabilities of the transporter. In this case files of any type may be sent to the server 136 (Column 40, lines 22 – 25). Specifically, Rourke et al. teach printing a document and Reisman teaches the capability of sending, which means the combination is configured to perform a plurality of operations on a single digital file. It should be noted that a server being configured to perform and actually performing those method steps are two different things especially within the broadest most reasonable interpretation of the claimed language. Furthermore, by applicant's own admission Reisman discloses ... sending and fetching information objects (Applicant's Arguments, 8/25/05, p 9, last paragraph – p 10, first sentence).
5. In response to applicant's argument that the Senn "attributes" have nothing to do with action objects that pertain to, for example, emailing, printing, faxing, and/or converting the document to another format (p 13, second paragraph), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.
6. In response to Applicant's argument that Senn does not teach, disclose, or suggest building a job object including a plurality of action objects; and performing the action objects on the digital file, it should be noted that the Office does not rely on Senn et al. to explicitly teach such a limitation; however, WhatIs.com teaches that In computer programming, a script is a program or sequence of instructions that is interpreted or carried out by another program rather than by the computer processor (as a compiled program is) (http://search.chopsource.techtarget.com/sDefinition/0,290660,sid39_gci212948,00.html). Furthermore, by applicant's own admission, the Senn "attributes" pertain to displaying a document on a computer ... an "attribute" as defined by Senn is a piece of data stored in a document ... and can be modified by a script (Applicant's Arguments, 8/25/05, p 1, last paragraph), which implies a job object (attribute) that includes action objects in view of WhatIs.com's definition of a script.
7. In response to applicant's argument that the Rourke attributes and use thereof does not relate to or disclose, teach, or suggest the limitations of claim 6, wherein a job object including one or more action objects that pertain to, for example, emailing, printing, faxing, and/or converting the document to another format (p 14, first paragraph), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.
8. In response to Applicant's arguments regarding the Office's use of dictionary definitions (p 14, fifth paragraph), it should be noted that the critical date of extrinsic evidence showing a universal fact need not antedate the filing date. See MPEP § 2124 (MPEP § 2131.01).